



Paper No. 14

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OFFICE OF PETITIONS

In re Application of
Broglie, et al.
Application No. 09/643,579
Filed: August 22, 2000
Attorney Docket No. 07148-025003
For: GENES FOR MUTANT MICROSOMAL
DELTA-12 FATTY ACID DESATURASES AND
RELATED ENZYMES FROM PLANTS

ON PETITION

This is a decision on the petition filed December 4, 2002 (certificate of mailing date November 25, 2002), requesting, in effect, withdrawal of a Notice of Omitted Item(s) in a Nonprovisional Application (Notice), mailed September 26, 2002. The petition will be treated under 37 CFR 1.53(e).

The application was filed on August 22, 2000. However, on September 26, 2002, the Office of Initial Patent Examination Division mailed a Notice stating that the application had been accorded a filing date of August 22, 2000, and advising applicants that pages 37, 38 and 39 of the specification appeared to have been omitted.

In response, the present petition was filed. Petitioners argue that pages 37, 38 and 39 of the specification should be included with the papers filed on August 22, 2000, because they were originally filed in prior application No. 0232,948, the entire disclosure of which was incorporated by reference at the time of filing.

The petition is **DISMISSED**.

The mailing of a "Notice of Omitted Items" permits the applicants to either: (1) promptly establish prior receipt in the PTO of the items at issue (generally by way of a date-stamped postcard receipt (MPEP 503)), or (2) promptly submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date. An applicant asserting that the missing items were in fact deposited in the PTO with the application papers must file a petition (and the appropriate petition fee) with evidence of such deposit. An applicant desiring to submit the omitted items in a nonprovisional application and accept the date of such submission as the application filing date must file any omitted items with an oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such items and a petition under 37 CFR 1.182 (with the petition fee under 37 CFR 1.17(h)) requesting the later filing date within two months of the date of the "Notice of Omitted Items" (37 CFR 1.181(f)).

In this case, petitioners assert that the missing pages were actually deposited in the PTO on August 22, 2000 with the other application papers. However, they offer no proof to bolster their position.

Instead, applicants seek to add the pages to the present application on the basis that the pages are not new matter. However, no petition is necessary for that purpose. Additional pages of

specification may be entered by the primary examiner without a petition so long as the pages contain no new matter. See MPEP § 608.02(a).

MPEP 201.06(c) states that:

... an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

If applicants desire that pages 37, 38 and 39 be added to the application, the appropriate procedure is by way of amendment requesting the entry of the pages. Any such amendment should be filed prior to the first action on the merits and will be considered by the primary examiner.

Accordingly, the petition is inappropriate and is subject to dismissal.

The petition fee will not be refunded, since the petition was not necessitated by any error on the part of the USPTO.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of **August 22, 2000**. Pages 37, 38 and 39 will not be processed at this time.

Thereafter, the application will be forwarded to Technology Center 1600 for examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 308-6712.



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